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09/488,578

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Robert J. Snyder

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EXAMINER

HUYNH, BA

ART UNIT

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/488,578
Filing Date: January 21, 2000
Appellant(s): SNYDER ET AL.

Robert B. Levy
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/17/09 appealing from the Office action mailed 10/06/2008.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

Application 10/434,458, appeal.

Application 10/434,461, appeal,

Application 10/431,576, appeal,

Application 10/200,776, appeal,

Application 10/191,467, appeal,

Application 09/488,578, Notice of appeal filed.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-35 are rejected and pending in the application.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

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(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

"Supplemental Declaration of Alex Holtz under 35 USC 1.56" filed on 12/10/02

"1997 Annual Report", ParkerVision

"CameraManSTUDIO preliminary sales Manual" ParkerVision

Exhibit A: "CameraMan Studio", ParkerVision (Doc. Ref. AT1, incorporated in item #5 of the Declaration)

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1-35 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention as evidenced by the Alex Holtz declaration. Disclosed in the declaration are numerous marketing activities by the applicants since 1996 which bring the claimed inventions within the scope of a bar to patenting under 35 USC 102(b), including:

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1996: graphically disclosed the invention at the NAB 96 trade show.

4/1997: Demonstrated the first prototype, distributed brochures, market exploitation, proposed price, list of potential beta sites was kept, among which is the Rainbow Media Group. All at the NAB 97.

Sometime after the NAB 97: discussed sale with price to public, including the Rainbow Media Group.

At Infocom tradeshow, repeated the same activities as with the NAB 97.

10/1997: Disclosed the product (with significant source codes), distributed brochures describing features and functions of the products at Telecom 97 tradeshow. Offered sale with price to public, including Rainbow Media Group. Capable and ready for taking purchase order.

12/19/97: Signed a sale contract with Rainbow Media Group.

It has been held that if one discloses his or her own work more than 1 year before the filing of the patent application, that person is barred from obtaining a patent. In re Katz, 687 F.2d 450, 454, 215 USPQ 14, 17 (CCPA 1982). The 1-year time bar is measured from the U.S. filing date. Thus, applicant will be barred from obtaining a patent if the public came into possession of the invention on a date before the 1-year grace period ending with the U.S. filing date. In this case the filing date of this application is December 18, 1998. It does not matter how the public came into possession of the invention. Public possession could occur by a public use, public sale, a publication, a patent or any combination of these. The proper test for the public use prong of the § 102 (b) statutory bar is whether the purported use: (1) was accessible to the public; or (2) was commercially exploited. Evidences of commercial activities include:

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(A) Preparation of various contemporaneous “commercial” documents, e.g., orders, invoices, receipts, delivery schedules, etc.

(B) Preparation of price lists (*Akron Brass Co. v. Elkhart Brass Mfg. Co.*, 353 F.2d 704, 709, 147 USPQ 301, 305 (7th Cir. 1965) and distribution of price quotations (*Amphenol Corp. v. General. Time Corp.*, 158 USPQ 113, 117 (7th Cir. 1968));

(C) Display of samples to prospective customers (*Cataphote Corp. v. DeSoto Chemical Coatings, Inc.*, 356 F.2d 24, 27, 148 USPQ 527, 529 (9th Cir. 1966) mod. on other grounds, 358 F.2d 732, 149 USPQ 159 (9th Cir.), cert. denied, 385 U.S. 832 (1966); *Chicopee Mfg. Corp. v. Columbus Fiber Mills Co.*, 165 F.Supp. 307, 323-325, 118 USPQ 53, 65-67 (M.D.Ga. 1958));

(D) Demonstration of models or prototypes (*General Elec. Co. v. United States*, 206 USPQ 260, 266-67 (Ct. Cl. 1979); *Red Cross Mfg. v. Toro Sales Co.*, 525 F.2d 1135, 1140, 188 USPQ 241, 244-45 (7th Cir. 1975); *Philco Corp. v. Admiral Corp.*, 199 F. Supp. 797, 815-16, 131 USPQ 413, 429-30 (D.Del. 1961)), especially at trade conventions (*InterRoyal Corp. v. Simmons Co.*, 204 USPQ 562, 563-65 (S.D. N.Y. 1979)), and even though no orders are actually obtained (*Monogram Mfg. v. F. & H. Mfg.*, 144 F.2d 412, 62 USPQ 409, 412 (9th Cir. 1944));

(E) Use of an invention where an admission fee is charged (*In re Josserand*, 188 F.2d 486, 491, 89 USPQ 371, 376 (CCPA 1951); *Greenewalt v. Stanley*, 54 F.2d 195, 12 USPQ 122 (3d Cir. 1931)); and

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(F) Advertising in publicity releases, brochures, and various periodicals (In re Theis, 610 F.2d 786, 792 n.6, 204 USPQ 188, 193 n. 6 (CCPA 1979); 3 InterRoyal Corp. v. Simmons Co., 204 USPQ 562, 564-66 (S.D.N.Y.1979); Akron Brass, Inc. v. Elkhart Brass Mfg., Inc., 353 F.2d 704, 709, 147 USPQ 301, 305 (7th Cir.1965); Tucker Aluminum Prods. v. Grossman, 312 F.2d 393, 394, 136 USPQ 244, 245 (9th Cir. 1963)).

As set forth above, evidences of commercial activities from A through F are all shown in Mr. Holtz declaration. Commercial activity was also disclosed on page 9 of the 1997 Annual Report, wherein “The company’s revenues to date consist of sales of CamaraMan systems and various accessories which complement those systems. Revenues for the years ended December 31, 1997, 1996 and 1995 were \$10,799,067, \$9,195,811, and \$3,902,546, respectively”.

The 9/18/96 Preliminary Sales Manual describes the CameraManSTUDIO as having a unique proprietary feature called TransitionMacro which allows the creation of real time control sequences. A control sequence can include video effects, audio mix, VCR commands, and camera controls. The TransitionMacro can then be assigned to a single button for playback and can also be edited using a simple GUI editor. A ShotPROFILER records joystick movements. Combining a shot profile with a TransitionMacro will create a very complex transition with an automated camera move. The Preliminary Sales Manual includes price list for the CameraManSTUDIO and its accessories. The CameraManSTUDIO was completed and ready for patented as evident from the printout brochures and the 9/18/96 CameraManSTUDIO Preliminary Sales Manual (see the entire manual). The Preliminary

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Sale Manual discloses listed functions performed by the CameraManSTUDIO, such as the creating of Transition Macro files, the GUI, the HOT Keys, the Shot Profiles, the Shot Directors, etc... The declaration Exhibit A was disclosed at the trade shows. This exhibit A lists substantially the same functions of the CameraManSTUDIO as in the Preliminary Sale Manual. Exhibit A's disclosed features of Transition Macro files and interactive CameraMan SCRIPT Viewer. Transition Macro and CameraMan Script viewer are time-based commands. The limitation "at least one scripted portion that includes at least one command activated during a predetermined interval in a script that undergoes scrolling for display under control of an operator" appears inherently included in the interactive CameraManSCRIPT Viewer. And the limitation "at least one non-scripted portion that includes at least one command activated independent of the script" appears inherently included in the TransitionMacro. It has been held that if a product that is offered for sale inherently possesses each of the limitations of the claims, then the invention is on sale, whether or not the parties to the transaction recognize that the product possesses the claimed characteristics (Atlas Powder Co. v. Ireco, Inc., 190 F.3d 1342, 1348-49 (Fed. Cir. 1999)).

The 1997 Annual Report, published in 1998, discloses the sale of the CameraManStudio in 1996 and 1997 which are evidences of commercial activities of the claimed invention before the critical date. In certain circumstances, references cited to show a universal fact need not be available as prior art before applicant's filing date. In re Wilson, 311 F.2d 266, 135 USPQ 442 (CCPA 1962).

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Mr. Holtz declaration expressly admitted that, in addition to the GUI, various prototypes and marketing documents (exhibits A, C) were displayed and distributed to the public in various trade shows (the declaration, par 3, 5-15).

Experimental use does not include market testing where the inventor is attempting to gauge consumer demand for his claimed invention. The purpose of such activities is commercial exploitation and not experimentation. In re Smith, 714 F.2d 1127, 1134, 218 USPQ 976, 983 (Fed. Cir. 1983). Further, experimentation to determine product acceptance, i.e., market testing, is typical of a trader's and not an inventor's experiment and is thus not within the area of permitted experimental activity. Smith & Davis Mfg. Co. v. Mellon, 58 F. 705, 707 (8th Cir. 1893) Likewise, testing of an invention for the benefit of appeasing a customer, or to conduct "minor tune up" procedures not requiring an inventor's skills, but rather the skills of a competent technician," are also not within the exception. In re Theis, 610 F.2d 786, 793, 204 USPQ 188, 193-94 (CCPA 1979).

Par. 8 of the declaration clearly states that proposed prices were provided to potential buyers. It should also be noted that the terms "production level" and "beta level" of the CameraManSTUDIO has multiple versions. The versions presented to the public during the above tradeshow may not be the version of the final version of the CameraManSTUDIO which the applicant is referring to in the argument. For the clarity of the record, it is respectfully request that all arguments should be directed to versions of the CameraManSTUDIO presented to the public one year prior to the filing date of this instant application. It is the examiner's opinion that the instant claim limitations were disclosed to the public in those CameraManSTUDIO versions during the above tradeshow. The terms

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“production level” and “beta level” of the CameraManSTUDIO appear directed to the real-time, live television capability version of the CameraManSTUDIO. In addition, price and beta version of the CameraManSTUDIO were offered to the public between April 97 and December 19, 1997 (see the declaration, par11-15). Conditional Sale May Bar a Patent An invention may be deemed to be “on sale” even though the sale was conditional. The fact that the sale is conditioned on buyer satisfaction does not, without more, prove that the sale was for an experimental purpose. *Strong v. General Elec. Co.*, 434 F.2d 1042, 1046, 168 USPQ 8, 12 (5th Cir. 1970).

(10) Response to Argument

The appellant argues that the Examiner’s rejection of the pending claims is inconsistent with the allowance of claims 117, 119, and 120 in a related application 10/121,608. In response to the argument, claims 117, 119 and 120, now patented claims 1-3, have different limitations. The reason for allowance of claims 1-3 had been clearly made of record in the 8/28/07 Notice of Allowance. Namely, the prior art of record (in 10/121,608) fail to clearly teach or fairly suggest the sending of the predetermined control commands occurs at a predetermined time along a time line as indicated by a step mark, wherein movement of the step mark can be automatically paused at a predetermined time prior to the sending, with the sending executed upon the resumption movement of the step mark along the time line, the resumption occurring in response to user activation. Such limitation is not recited in the now appeal claims. If the appellant still has question about the validity of the allowed claims, such issue is a separate issue and will not be discussed in this appeal.

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The appellant further argues that, as explained in the declaration, “a number of critical features and functions of the invention had not been conceived by December 19, 1997”, however the appellant had not unveiled what are “the number of critical features and functions” that had not been conceived. Thus the argument is insufficient to show that the limitations of the claims invention as recited were not been known and/or on sale to the public prior to 12/19/97. The 12/10/02 Declaration filed by Mr. Alex Holtz clearly declares a number of commercial activities of the now claimed invention, being known as the CameraManSTUDIO at various trade shows, including:

1996: graphically disclosed the invention at the NAB 96 trade show. See also the appellant’s argument, page 14, lines 5-8.

4/1997: Demonstrated the first prototype, distributed brochures, market exploitation, proposed price, list of potential beta sites was kept, among which is the Rainbow Media Group. All at the NAB 97. See also the appellant’s argument, page 14, lines 11-15, lines 20-28.

Sometime after the NAB 97: discussed sale with price to public, including the Rainbow Media Group.

At Infocom tradeshow, repeated the same activities as with the NAB 97. See also the appellant’s argument, page 14, lines 29-31.

10/1997: Disclosed the product (with significant source codes), distributed brochures describing features and functions of the products at Telecom 97 tradeshow. Offered sale with price to public, including Rainbow Media Group. Capable and ready for taking purchase order. See also the appellant’s argument, page 15, lines 1-3, 12-15, 21-25.

12/19/97: Signed a sale contract with Rainbow Media Group.

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It has been held that if one discloses his or her own work more than 1 year before the filing of the patent application, that person is barred from obtaining a patent. In re Katz, 687 F.2d 450, 454, 215 USPQ 14, 17 (CCPA 1982). The 1-year time bar is measured from the U.S. filing date. Thus, applicant will be barred from obtaining a patent if the public came into possession of the invention on a date before the 1-year grace period ending with the U.S. filing date. In this case the filing date of this application is December 18, 1998. It does not matter how the public came into possession of the invention. Public possession could occur by a public use, public sale, a publication, a patent or any combination of these. The proper test for the public use prong of the § 102 (b) statutory bar is whether the purported use: (1) was accessible to the public; or (2) was commercially exploited. Evidences of commercial activities include:

- (A) Preparation of various contemporaneous “commercial” documents, e.g., orders, invoices, receipts, delivery schedules, etc.
- (B) Preparation of price lists (Akron Brass Co. v. Elkhart Brass Mfg. Co., 353 F.2d 704, 709, 147 USPQ 301, 305 (7th Cir. 1965) and distribution of price quotations (Amphenol Corp. v. General. Time Corp., 158 USPQ 113, 117 (7th Cir. 1968));
- (C) Display of samples to prospective customers (Cataphote Corp. v. DeSoto Chemical Coatings, Inc., 356 F.2d 24, 27, 148 USPQ 527, 529 (9th Cir. 1966) mod. on other grounds, 358 F.2d 732, 149 USPQ 159 (9th Cir.), cert. denied, 385 U.S. 832 (1966); Chicopee Mfg. Corp. v. Columbus Fiber Mills Co., 165 F.Supp. 307, 323-325, 118 USPQ 53, 65-67 (M.D.Ga. 1958));

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(D) Demonstration of models or prototypes (General Elec. Co. v. United States, 206 USPQ 260, 266-67 (Ct. Cl. 1979); Red Cross Mfg. v. Toro Sales Co., 525 F.2d 1135, 1140, 188 USPQ 241, 244-45 (7th Cir. 1975); Philco Corp. v. Admiral Corp., 199 F. Supp. 797, 815-16, 131 USPQ 413, 429-30 (D.Del. 1961)), especially at trade conventions (InterRoyal Corp. v. Simmons Co., 204 USPQ 562, 563-65 (S.D. N.Y. 1979)), and even though no orders are actually obtained (Monogram Mfg. v. F. & H. Mfg., 144 F.2d 412, 62 USPQ 409, 412 (9th Cir. 1944));

(E) Use of an invention where an admission fee is charged (In re Josserand, 188 F.2d 486, 491, 89 USPQ 371, 376 (CCPA 1951); Greenewalt v. Stanley, 54 F.2d 195, 12 USPQ 122 (3d Cir. 1931)); and

(F) Advertising in publicity releases, brochures, and various periodicals (In re Theis, 610 F.2d 786, 792 n.6, 204 USPQ 188, 193 n. 6 (CCPA 1979); 3 InterRoyal Corp. v. Simmons Co., 204 USPQ 562, 564-66 (S.D.N.Y.1979); Akron Brass, Inc. v. Elkhart Brass Mfg., Inc., 353 F.2d 704, 709, 147 USPQ 301, 305 (7th Cir.1965); Tucker Aluminum Prods. v. Grossman, 312 F.2d 393, 394, 136 USPQ 244, 245 (9th Cir. 1963)).

More commercial activities was also disclosed on page 9 of the 1997 Annual Report, wherein “The company’s revenues to date consist of sales of CamaraMan systems and various accessories which complement those systems. Revenues for the years ended December 31, 1997, 1996 and 1995 were \$10,799,067, \$9,195,811, and \$3,902,546, respectively”.

In addition, the 9/18/96 Preliminary Sales Manual describes the CameraManSTUDIO as having a unique proprietary feature called TransitionMacro which allows the creation of real time control sequences. A control sequence can include video effects, audio mix, VCR commands, and camera controls. The TransitionMacro can then be assigned to a single button for playback and can also be edited using a simple GUI editor. A ShotPROFILER records joystick movements. Combining a shot profile with a TransitionMacro will create a very complex transition with an automated camera move. The Preliminary Sales Manual includes price list for the CameraManSTUDIO and its accessories. Even though the 9/19/96 Preliminary Sale Manual is confidential, it does prove that the CameraManSTUDIO was completed and ready for patented as evident from the printout brochures and the 9/18/96 CameraManSTUDIO Preliminary Sales Manual (see the entire manual). The 9/18/96 Preliminary Sale Manual also proves that list of functions as currently recited in the claims, have been offered to the public, including the creating of Transition Macro files, the GUI, the HOT Keys, the Shot Profiles, the Shot Directors, etc...

In addition, the declaration Exhibit A was disclosed at the trade shows. This exhibit A lists substantially the same functions of the CameraManSTUDIO as in the Preliminary Sale Manual. Exhibit A discloses features of Transition Macro files and interactive CameraMan SCRIPT Viewer. Transition Macro and CameraMan Script viewer are time-based commands. The limitation "at least one scripted portion that includes at least one command activated during a predetermined interval in a script that undergoes scrolling for display under control of an operator" appears inherently included in the interactive CameraManSCRIPT Viewer. And the limitation "at least one non-scripted portion that

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includes at least one command activated independent of the script” appears inherently included in the TransitionMacro. It has been held that if a product that is offered for sale inherently possesses each of the limitations of the claims, then the invention is on sale, whether or not the parties to the transaction recognize that the product possesses the claimed characteristics (*Atlas Powder Co. v. Ireco, Inc.*, 190 F.3d 1342, 1348-49 (Fed. Cir. 1999)).

In addition, the 1997 Annual Report, published in 1998, discloses the sale of the CameraManStudio in 1996 and 1997 which are evidences of commercial activities of the claimed invention before the critical date (In certain circumstances, references cited to show a universal fact need not be available as prior art before applicant’s filing date. In *re Wilson*, 311 F.2d 266, 135 USPQ 442 (CCPA 1962)).

The appellant argues that the above activities were for experimental purpose to perfect the invention. In response to the argument, it has been held that experimental use does not include market testing where the inventor is attempting to gauge consumer demand for his claimed invention. The purpose of such activities is commercial exploitation and not experimentation. In *re Smith*, 714 F.2d 1127, 1134, 218 USPQ 976, 983 (Fed. Cir. 1983). Further, experimentation to determine product acceptance, i.e., market testing, is typical of a trader’s and not an inventor’s experiment and is thus not within the area of permitted experimental activity. *Smith & Davis Mfg. Co. v. Mellon*, 58 F. 705, 707 (8th Cir. 1893) Likewise, testing of an invention for the benefit of appeasing a customer, or to conduct “minor tune up” procedures not requiring an inventor’s skills, but rather the skills of a competent technician,” are also not within the exception. In *re Theis*, 610 F.2d 786, 793, 204 USPQ 188, 193-94 (CCPA 1979). The

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declaration clearly states that proposed prices were provided to potential buyers. In addition, price and beta version of the CameraManSTUDIO were offered to the public between April 97 and December 19, 1997 (see the declaration, par11-15). Conditional Sale May Bar a Patent An invention may be deemed to be “on sale” even though the sale was conditional. The fact that the sale is conditioned on buyer satisfaction does not, without more, prove that the sale was for an experimental purpose. *Strong v. General Elec. Co.*, 434 F.2d 1042, 1046, 168 USPQ 8, 12 (5th Cir. 1970). Clearly, market research, collecting names of buyers, offering product with sale price (declaration, #8, 9, 10, 11, 14, 15) are all commercial activities.

The appellant further argues that “the invention” was not ready for patenting prior to the critical date. In response to the argument, the claim invention was “ready for patenting” as showing by drawing and descriptions in the distributed Exhibit A (declaration, #5). Exhibit A discloses features of Transition Macro files and interactive CameraMan SCRIPT Viewer. Transition Macro and CameraMan Script viewer are time-based commands. The limitation “at least one scripted portion that includes at least one command activated during a predetermined interval in a script that undergoes scrolling for display under control of an operator” appears inherently included in the interactive CameraManSCRIPT Viewer. And the limitation “at least one non-scripted portion that includes at least one command activated independent of the script” appears inherently included in the TransitionMacro. The appellant did not response to the inherency finding of the examiner. Thus the claim invention was ready for patenting since Exhibit A discloses all limitations recited the claims now seeking for patenting. It is noted that the

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CameraManSTUDIO as described in Exhibit A may not produce a real-time application, but it certainly ready for patenting as it is being claimed.

As set forth above evidences of public known of the claim invention were clearly shown the Mr. Alex Holtz declaration.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Ba Huynh/

Primary Examiner, Art Unit 2179

Conferees:

/Steven B Theriault/

Primary Examiner, Art Unit 2179

/Weilun Lo/

Supervisory Patent Examiner, Art Unit 2179